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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,899	04/27/2007	Jean-Charles Schwartz	P08977US00/BAS	8912

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EXAMINER	
SPIVACK, PHYLLIS G	
ART UNIT	PAPER NUMBER
1614	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/587,899	SCHWARTZ ET AL.	
	Examiner	Art Unit	
	Phyllis G. Spivack	1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 April 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 5-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 5-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

The request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after Final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office Action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on January 22, 2010 has been entered.

Applicants' Response filed April 28, 2010 to the Restriction Requirement mailed January 28, 2010 is acknowledged. Upon reconsideration, the Restriction Requirement is withdrawn. The search has been extended to include a method for the treatment of acute gastroenteritis, claims 14 and 17-19, and a method for the treatment of acute diarrhea associated with emesis, claims 15 and 16. Claims 2-4 are canceled. New claims 20-24 are presented. Accordingly, claims 1 and 5-24 are examined in their entirety.

The abstract of the disclosure is objected to because it does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(4). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

See MPEP § 608.01(b).

Claim 23 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 5. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim 24 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 20. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claims 5-19 and 24 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicants are required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form. Independent claims 1 and 23 recite a combination "consisting essentially of" and thus the scope of the claims is limited to the specifically recited compounds and other agents that do not materially affect the basic and novel characteristics of the claimed invention. See *In re Herz*, 537 F.2d 549,551-52, 190 USPQ 461, 463 (CCPA 1976). Dependent claims 5-19 and 24 recite "comprising" language and are, therefore, fully open to the inclusion of any other active or inactive component.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-19 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Dependent claims 5-19 and 24 lack clarity in that each employs an open language format that permits the addition of any number of active or inactive agents in the claimed "combination" of independent claims 1 and 23, respectively. The independent claims are limited to the combination consisting essentially of racecadotril or dexecadotril with ~~e~~ndansetron or granisetron. Therefore, no other agent that materially affects the basic and novel characteristics of the claimed invention is permitted in any of the claims.

The recitation in claim 17, "preferably two to four times a day" is indefinite. It is unclear whether or not a claim limitation is intended.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 5-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Clear support for the amendment to claim 1, i.e., language drawn to a combination "consisting essentially of" is not provided by Applicants and appears to be absent. See *In re Rasmussen*, 21 USPQ 323 (CCPA 1981).

Applicants' arguments with respect to claims 1-19 that were rejected under 35 U.S.C. 103(a), as being unpatentable over Stroppolo et al., US 2004/0115258, in view of Boige et al., Bulletin du Cancer, in the last Office Action, have been considered but are moot in view of the new ground of rejection.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 and 5-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cojocaru et al., Archives Pediatrics, in view of Cubeddu et al., Alimentary Pharmacol. Ther., and Boige et al., Bulletin du Cancer.

Cojocaru teaches the administration of racecadotril in the treatment of diarrhea. Racecadotril is an inhibitor of enkephalins (endogenous opioid peptides) that causes a reduction in intestinal secretion. See the Summary, pages 774-775. As an optical isomer of racecadotril, it would have been reasonable to expect dexecadotril to exhibit similar pharmacologic properties. Cubeddu teaches the administration of the 5-HT3 receptor antagonist ondansetron, as an antiemetic in the treatment of gastroenteritis. Boige, a document that is drawn to digestive complications of cancer chemotherapy, teaches the administration of ondansetron, granisetron and racecadotril to treat nausea, vomiting and diarrhea. See the discussions under **Prevention et traitement specifiques** and **Diarrhee**. Nausea, vomiting and diarrhea frequently occur following

the administration of various cancer chemotherapeutic agents and regimens. Boige teaches an oral dosage of granisetron to be 1 mg every 12 hours, an oral dosage of ondansetron to be 8 mg every 8 hours and an intravenous dosage of ondansetron to be 32 mg. Additionally, dosages based on mg/kg body weight are provided. The specific enkephalinase inhibitor acetorphan, which is racecadotril, at a dosage of 300 mg/day, is specifically indicated in late-onset diarrhea.

In re Diamond and Kellman, 149 USPQ 562 (CCPA 1966), supports the obviousness of combining drugs known to be useful for the same purpose. In *Diamond*, Appellants were claiming a combination of adenosine-5-monophosphate and a glucocorticoid. The Examiner cited prior art teaching adenosine-5-monphosphate and glucocorticoids were known in the art to be useful for treating collagen diseases and that combining drugs for the treatment of disease is suggested by the prior art. Appellants argued that the combination of the two drugs is non-obvious since there is no teaching to combine these two out of all known anti-inflammatory agents. The Court was not persuaded by this argument, stating that:

"...we think it clear that it is a standard practice in this art to combine ingredients."

"We are not convinced of non-obviousness of the combination of the two drugs, adenosine-5-monophosphate and a glucocorticoid such as hydrocortisone, for use as an anti-inflammatory composition, particularly since the record supports the solicitor's contention that the drugs selected are two of the commonly used drugs in the treatment of such collagen diseases."

The Declaration by Dr. Jeanne-Marie Lecomte filed April 2, 2009 has been reconsidered. It appears that the combined administration of racecadotril and

granisetron suppresses the adverse effect of racecadotril administration, i.e., an increase in intestinal transit time. However, the showing is not commensurate in scope with the present claims. There is no disclosed dosage for either of the agents. Favorable consideration would be given to a showing wherein the effective amounts, as, for example, in instant claims 9 and 10, are employed and a synergistic effect is demonstrated.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Phyllis G. Spivack whose telephone number is 571-272-0585. The Examiner can normally be reached from 10:30 to 7 PM.

If attempts to reach the Examiner by telephone are unsuccessful after one business day, the Examiner's supervisor, Ardin Marschel, can be reached 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 14, 2010

/Phyllis G. Spivack/
Primary Examiner, Art Unit 1614